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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,482	02/10/2004	Mark Andrew Smith	927-26-034	3246
23935 7590 11/16/2007 KOPPEL, PATRICK & HEYBL 555 ST. CHARLES DRIVE SUITE 107 THOUSAND OAKS, CA 91360			EXAMINER CHORNESKY, ADAM B	
			ART UNIT 4127	PAPER NUMBER
			MAIL DATE 11/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/776,482

Applicant(s)

SMITH, MARK ANDREW

Examiner

Adam Chornesky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/13/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☒ Certified copies of the priority documents have been received in Application No. 10/776,482.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/04/2004</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following is a non-final, first office action on the merits. Claims 1-18 are pending.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-3, 6, 7, 11-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Small (US 4815741 A).**

As per claim 1, Small discloses an award indicating device for use at a point of sale location having point of sale equipment (abstract lines 1-4 via an apparatus and method for automated marketing and gaming wherein a player inserts an identification card into an automated remote interface device and accesses an account at a subject financial institution),

said device comprising an automatic selector which is operable, when actuated, to select an outcome from a range of outcomes at least one of which corresponds to the indication of an available award (abstract lines 7-9 via a sweepstakes processor compares the user and game indicia to determine whether a selected winning correlation is present),

said device being mountable at said point of sale location, and an actuating device being provided which is operable to effect actuation of the said selector in

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association with the said point of sale equipment (col. 3 lines 47-49 via a sweepstakes-type game which utilizes a network apparatus such as an ATM or POS device).

As per claim 2, Small discloses an operable switch (col. 3 lines 17-20 via a transmission switch facilities device, commonly known as a switch),

and a display device associated therewith (col. 2 lines 61-64 via a user interacts with an interface device, such as a remote computer terminal, and more particularly an automated teller machine (ATM) or point-of-sale (POS) terminal).

As per claim 3, Small discloses that the operable switch is remotely located relative to the display device (abstract line 3 via an automated remote interface device) and (col. 3 lines 17-22 via a transmission facilities device, commonly known as a switch).

As per claim 6, Small discloses that the display device comprises a selection device and a display feature (col. 1 lines 19-21 via selection of a series of numbers by a player and the comparison of same to a random pre-selected number).

As per claim 7, Small discloses that the selection device is a moveable element (abstract lines 2-6 via an identification card where user indicia are compared to a game indicia).

As per claim 11, Small discloses that the selection device operates in conjunction with the display feature (col. 2 lines 63-64 via an automated teller machine (ATM) or point-of-sale (POS) terminal).

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As per claim 12, Small discloses that the selection device is moveable relative to the display feature (col. 2 lines 65-66 via a magnetically encoded debit card is inserted into the ATM or POS terminal).

As per claim 13, Small discloses that the display feature comprises symbol bearing regions on the selection device (col. 2 lines 35-37 via a user-specific indicia thereto for matching to a randomly selected game indicia).

As per claim 14, Small discloses that the award selector is controlled by a microprocessor control unit (col. 2 lines 27-30 via a game apparatus which utilizes a sweepstakes game computer in conjunction with a financial institution data processor and a remote interface device).

As per claim 15, Small discloses that the actuating device operates on a random (or pseudo-random), or predetermined basis (col. 3 line 4 via means for generating a random game indicia).

As per claim 16, Small discloses that the actuating device is vendor operated (col. 2 lines 62-64 via an interface device, such as a remote computer terminal, and more particularly an automated teller machine (ATM) or point-of-sale (POS) terminal).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Small (US 4815741 A) in view of Church (US 3659853 A).

As per claim 5, Small discloses all the elements of the claimed invention as described in claim 3 above, but does not disclose that the operable switch is a push button.

Church discloses an electronic dice game device with the concept of having operable switch (col. 1 line 58 via an operating switch 28) that is a push-button switch (col. 3 line 4 via the push-button operating switch 28).

Therefore, from the teaching of Church, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the automated marketing and gaming systems of Small to include operating push-button switch of Church in order to achieve realistic game simulation (col. 1 lines 11-12).

As per claim 9, Small discloses all the elements of the claimed invention as described in claim 6 above, but fails to disclose that the selection device is an illuminating device comprising a plurality of selectively illuminable light sources.

Church discloses an electronic dice game device with the concept of having a selection device that is an illuminating device comprising a plurality of selectively illuminable light sources (abstract lines 1-2 via two banks of seven electric lamps).

Therefore, from the teaching of Church, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the automated marketing and gaming system of Small to include the light sources of Church in order to achieve realistic game simulation (col. 1 lines 11-12).

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Small (US 4815741 A) in view of Sorenson (US 4383154 A).

As per claim 4, Small discloses all the elements of the claimed invention as described in claim 3 above, but does not disclose that the operable switch is a rocker-switch or a lever.

Sorenson discloses that the operable switch is a rocker-switch or a lever (col. 3 lines 20-21 via a two position rocker switch having on/off capability).

Therefore, from the teaching of Sorenson, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the automated marketing and gaming systems of Small to include the a two position rocker switch having on/off capability of Sorenson in order to improve the stability characteristics of the switch positions (col. 1 lines 7-8).

6. Claim 8, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Small (US 4815741 A) in view of Rodesch et al. (US 4099722 A).

As per claim 8, Small discloses all the elements of the claimed invention as described in claim 7 above, but does not disclose that the moveable element is a pointer, a disc or a reel.

Rodesch et al. discloses an electronic slot machine system with the concept that the moveable element is a pointer, a disc or a reel (abstract lines 10-11 via a stepping motor steps the reels).

Therefore, from the teaching of Rodesch et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the automated marketing and gaming systems of Small to include the movable reels of Rodesch et al. in order to provide a novel solid state gaming machine (col. 2 lines 25-26).

As per claim 17, Small discloses all the elements of the claimed invention as described in claim 1 above, but does not disclose that the selector is located within a protective housing.

Rodesch et al. discloses an electronic slot machine system with the concept that the selector is located within a protective housing (col. 1 lines 39-40 via symbol bearing reels visible through front viewing glass) and (col. 2 lines 65-66 via fully enclosed tamper-proof housing).

Therefore, from the teaching of Rodesch et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the automated marketing and gaming systems of Small to include the tamper-proof housing of Rodesch et al. in order to provide a more reliable and durable solid state gaming machine (col. 2 lines 32-34).

As per claim 18, Small discloses all the elements of the claimed invention as described in claim 17 above, but does not disclose that the housing comprises a slot for allowing the display feature to be readily changed.

Rodesch et al. discloses an electronic slot machine system with the concept that the housing comprises a slot for allowing the display feature to be readily changed (col.

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3 lines 55-56 via reels are individually removable with the same guide rail, self-seating plus arrangement).

Therefore, from the teaching of Rodesch et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the automated marketing and gaming systems of Small to include the individually removable reels of Rodesch et al. in order to significantly reduce maintenance and/or repair (col. 1 lines 33-34).

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Small (US 4815741 A) in view of Church (US 3659853 A) and further in view of Rodesch et al. (US 4099722 A).

As per claim 10, the Small and Church combination discloses all the elements of the claimed invention as described in claim 9 above, but does not disclose that the light sources are LED's.

Rodesch et al. discloses an electronic slot machine system with the concept that the light sources are LED's (col. 17 lines 12-13 via one of the gates illuminating the appropriate LED).

Therefore, from the teaching of Rodesch et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the automated marketing and gaming systems of Small to include the LED light sources of Rodesch et al. in order to provide a novel solid state gaming machine (col. 2 lines 25-26).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes:

Tozzi (US 3808709 A) teaches a power push-button switch in order to close the electric circuit to the battery or the general electric power supply system.

Gierwiatowski (US 2673739 A) teaches an automatic phonograph player with a selector mechanism and includes a selector display with replaceable parts.

Olson et al. (US 3007362 A) teaches a combination random-probability system using electronic means, and is relevant to the current invention.

Hinterstocker (US 3819186 A) teaches an electronic automatic roulette game having a simulated number cup and a simulated revolving ball. The cup includes a plurality of lights which are energized in succession under control of an oscillator to simulate the revolving ball.

Ottenstein (US 4064555 A) teaches an apparatus for modification of a gasoline pump. This apparatus incorporates electronically driven display numerals.

Small (US 4669730 A) teaches an apparatus and method for playing a sweepstakes-type game wherein a player inserts an identification card into an automated remote computer terminal and accesses an account at a subject financial institution.

Ferguson et al. (US 5256863 A) teaches a system for automating data acquisition and processing at a checkstand point-of-sale in a retail outlet.

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Deaton et al. (US 5642485 A) teaches a method and system for selective incentive point-of-sale marketing in response to customer shopping histories.

Bennett (US 5642160 A) teaches a digital image capture system for photo identification cards.

Hobbs et al. (US 5883620 A) teaches an electronic prize verification and display apparatus, where the display apparatus preferably includes a keypad and liquid crystal display.

Humble (US 6048268) teaches an electronic promotional game which preferably operates in conjunction with a point of sale terminal having a processor and includes an electronic display screen for displaying the image of a game card.

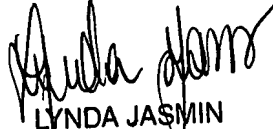
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Chornesky whose telephone number is 571-270-5103. The examiner can normally be reached on Monday - Thursday 7:30 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on 571-270-3033. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A. Chornesky

 11/9/07
LYNDA JASMIN
SUPERVISORY PATENT EXAMINER